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EXAMINER

CORRIELUS, JEAN M

ART UNIT PAPER NUMBER

2162

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,183

Applicant(s)

CAPPS, STEPHAN P.

Examiner

Jean M. Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the Request for Continued Examination filed on June 26, 2006, in which claims 1, 2 and 4-50 are presented for further examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26, 2006 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2 and 4-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed. In particular, the claimed feature of "interfacing with display rendering routines of a computing device to recover electronic information being displayed on a display device coupled to the computing device; automatically interpreting and parsing the recovered

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electronic information” in claims 1, 24 and 37 are not described in the specification to enable one having ordinary skill in the art to make and use the invention. The specification paragraph [0020] automatically interfaces with display rendering routines of a computer system, wherein the display screen of a computer is rendered in response to instructions, i.e., the display input, such as, for example compiled software code, such as a typical computer program, or, interpreted page descriptions such as an HTML or similar script. Consequently, this working example essentially scans or parses all information viewable by the user, as well as hidden text or instructions, such as, for example, hidden text embedded in the HTML code of an Internet web page, to find persons. However, such abovementioned of the specification does not provide form information to a client computer. Based on the analysis provided above and substantial evidence or reasoning, the examiner provided that one having ordinary skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. The limitation as claimed in claims 1, 24 and 37 **“interfacing with display rendering routines of a computing device to recover electronic information being displayed on a display device coupled to the computing device; automatically interpreting and parsing the recovered electronic information”** are not supported by the as-filed disclosure, which is violated the written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Applicant should duly note that the first paragraph of 35 U.S.C. 112 requires that the “specification shall contain a written description of the invention”. Applicant should also note that the essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed; and to put the public in possession of what the applicant claims as the invention.” Furthermore, the written

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description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term.

Indeed, the specification does not satisfy the written description requirement because the specification does not describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee US Pub. No. 2002/0087521 and Thorner et al., (hereinafter "Thorner") US Patent no. 6,463,443.

As to claim 1, Lee discloses "automatically interpreting and parsing the recovered electronic document to identify data representing any person" by automatically dividing the electronic file into separately searchable word sets, wherein the division made according to sentence and paragraph breaks in the file (page 1, [0006], [0015], [0019]); "identifying at least one person represented by the identified data" identifying word or words sequences which represented candidate names (page 1, [0007], [0012],[0020]).. Lee does not explicitly disclose the claimed "automatically retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available; and using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide at least one electronic interface for initiating communication with those identified persons; and "interacting with display rendering routines of a computing device to recover electronic information being displayed on a display device coupled to the computing device". On the other hand, Thorner teaches the claimed automatically retrieving information relating to each identified person from at least one electronic database" (col.4, lines 59-67; col.6, lines 27-39); "notifying the user that the retrieved information is available" (Thorner, col.4, lines 40-61, CCA person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject -information . . .")' and "using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide at least one electronic interface for initiating

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communication with those identified persons (Thorner col. 4, lines 62-67, (Automatic connection to a inquired person/family/company", col. 7, lines 43-55); and "interacting with display rendering routines of a computing device to recover electronic information being displayed on a display device coupled to the computing device" (the search is performed and the desired catalogue data is presented visually on a display of the terminal asking for the subject information (col.7, line 48-col.8, line 18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the system for searching electronic files as disclosed by Lee would incorporate the use of automatically retrieving available information and providing at least one electronic interface for initiating communication with those identified person. One having ordinary skill in the art would have found it motivated to combine the teachings of the cited references in order to provide desired information about person's communication possibilities and residence in easy way without installation adapted to particular kind of communications system.

As per claim 4, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner discloses the claimed "wherein the at least one electronic interface for initiating communication with one or more of the identified persons includes any of an email address, an instant message, a telephone number, a fax number, and an Internet address for communicating with the identified person (Thorner, col. 7, lines 42-55).

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As per claim 5, Lee and Thorner teach substantially the invention as claimed. In addition, Lee teaches the claimed “wherein parsing an electronic document to identify data representing any person comprises identifying textual data associated with any person (Lee, page 1, (00051-(0020), page 2, (0032)-g0033)).

As per claims 6 and 35, Lee and Thorner teach substantially the invention as claimed. In addition, Lee teaches the claimed “wherein the textual data associated with any person includes any of: a name, an email address, a telephone number, a fax number, and a social security number (Lee, page 1, (00051-(0020), page 2, (0032)-(0033)).

As per claims 9 and 36, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner teaches the claimed “wherein identifying at least one person represented by the identified data comprises comparing the identified data to information in at least one electronic database to identify each person associated with the identified data (Thorner, col. 4, lines 40-67).

As per claim 11, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner teaches the claimed “wherein notifying the user that the retrieved information is available comprises automatically providing a visible alert when the information is retrieved from the at least one electronic database (Thorner, col. 8, lines 15-20).

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As per claim 20, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner teaches a graphical user interface for interacting with the retrieved information” (Thorner, col. 4, lines 62-67).

As per claim 24, Lee teaches a computer-implemented process for automatically providing information on a computer display device, comprising: “automatically scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person (Lee, page 1, (00052- (0020), page 2, (0032)- (0033)); identifying each person represented by the identified information (Lee, page 1, (00052- (0020), page 2, (0032)-(0033)). Lee does not explicitly disclose automatically retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available; using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide a user interface for initiating communication with those identified persons via at least one electronic communication access point. On the other hand, Thorner teaches the claimed automatically retrieving information relating to each identified person from at least one electronic database” (col.4, lines 59-67; col.6, lines 27-39); “notifying the user that the retrieved information is available” (Thorner, col.4, lines 40-61, CCA person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject -information . . .”) and “using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide at least one electronic interface for initiating communication with those identified persons (Thorner col. 4,

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lines 62-67, (Automatic connection to a inquired person/family/company", col. 7, lines 43-55); and "interacting with display rendering routines of a computing device to recover electronic information being displayed on a display device coupled to the computing device" (the search is performed and the desired catalogue data is presented visually on a display of the terminal asking for the subject information (col.7, line 48-col.8, line 18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the system for searching electronic files as disclosed by Lee would incorporate the use of automatically retrieving available information and providing at least one electronic interface for initiating communication with those identified person. One having ordinary skill in the art would have found it motivated to combine the teachings of the cited references in order to provide desired information about person's communication possibilities and residence in easy way without installation adapted to particular kind of communications system.

8. Claim 2 is rejected under 35 U.S.C. 1 03(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) and Thorner et al., (hereinafter "Thorner" US 6,463,443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view of Srinivasan (US 6,717,936).

As per claim 2, Lee and Thorner substantially teach the invention as claimed. However, neither Lee nor Thorner explicitly discloses the at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one communication access point related to the retrieved information. Srinivasan teaches the claimed "at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one

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communication access point related to the retrieved information” (Srinivasan, col. 6, lines 62-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lee and Thorner's combined system by incorporating the icon as disclosed by Srinivasan (Srinivasan's col. 6 lines 62-64). One having ordinary skill in the art at the time the invention was made to use such a modification for the purpose of efficiently selecting mode for establishing communication between user and subscriber.

9. Claims 7, 8 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub.No. US 2002/0087521 A1) and Thorner et al. (Thorner" US 6,463,443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view of Dimitrova (US 6,363,380).

As per claim 7, Lee and Thorner substantially teach the invention as claimed, except for explicitly disclosing parsing an electronic document to identify data representing any person comprises identifying graphical data associated with any person. Dimitrova, on the other hand, teaches parsing graphical data to identify person (Dimitrova, col. 12, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating a graphical parser as disclosed by Dimitrova (Dimitrova, col. 12, lines 1-7). The motivation being to enable the system to identify not only textual data but also graphical data associated with a person.

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As per claim 8, Lee, Thorner and Dimitrova teach all the claimed subject matters as discussed in claim 7, and further teach the graphical data associated with any person includes any image for representing at least one person (Dimitrova, col. 12, lines 1-7).

As per claim 39, Lee, Thorner and Yamakita teach all the claimed subject matters as discussed in claim 38. In addition, Dimitrova teaches identifying characteristics of at least one image within the electronic document using at least one image recognition technique (Dimitrova, col. 12, lines 1-7).

10. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub No: US 2002/0087521 A1) and Thorner et al. (Thorner" US 6 463 443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view of Sorensen (US 6,628,729).

As per claims 10 and 12, Lee and Thorner substantially teach the invention as claimed, except for explicitly disclosing wherein notifying the user that the retrieved information is available comprises automatically providing an audible alert when the information is retrieved from the at least one electronic database. Sorensen teaches providing an audible alert when information is retrieved (Sorensen, col. 3, lines 27-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating an audio alert as disclosed by Sorensen (Sorensen, Col.3, lines 27-30). The motivation being to promptly reminder the user that information is available.

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11. Claims 13-15, 26-30, 37, 38, 40-45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee Pub No: US 2002/0087521 A1) and Thorner et al. (Thorner" US 6 463 443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view Yamakita (US 6,272,490).

As per claims 13, 15, 26-30, 37, 38, 40-45 and 50, Lee and Thorner substantially teach the invention as claimed, except for explicitly disclosing the visible alert comprises dynamically modifying the appearance of the electronic document. Yamakita teaches the visible alert comprises dynamically modifying the appearance of the electronic document (Yamakita, abstract, (word is highlighted"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by modifying the appearance of the electronic document as disclosed by Yamakita. The motivation being to notify the user the information is available.

As per claim 14, Lee, Lee and Thorner substantially teach the invention as claimed. In addition, Yamakita teaches the claimed "changing the appearance of the identified data"(, abstract, "word is highlighted").

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12. Claims 16-19, 21-23 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner" US 6,463,443) and further in view of Appelman et al. ("Appelman" US 6,539,421).

As per claims 16 and 31, Lee and Thorner substantially discloses the invention as claimed, except for explicitly disclosing the visible alert comprises dynamically adding at least one presence indicator to the electronic document. However, Lee and Thorner teach using electronic communication (email) to communicate with a person. On the other hand, Appelman teaches using instant messaging, which is a type of electronic communication system, to communicate with a person (Appelman, col. 4, lines 24-30). Instant messaging system provides a visible alert that adds presence indicator associated with the person (Appelman, col. 5, lines 52-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by using a instant messaging system with presence indicator as disclosed by Appelman to communicate with the identified person. The motivation being to provide a faster and efficient way to communicate with the identified person because with email system, the message sender will never know when the person will read the email and reply to the email message. Instant message system tells the user whether the person is online or not, and allows the user to communicate with the person right away in real time.

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As per claims 17 and 32-34, Lee, Thorner and Appelman substantially teach the invention as claimed. In addition, Appelman discloses the claimed “the instant message system provides online status (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which automatically determining an online status for each identified person by querying at least one messaging account server for each identified person.

As per claim 18 and 46-49, Lee, Thorner and Appelman substantially teach the invention as claimed. In addition, Appelman discloses the claimed “each presence indicator graphically represents the online status of each identified person” (Appelman, col. 5, lines 52-55).

As per claim 19, Lee, Thorner and Appelman substantially teach the invention as claimed. In addition, Appelman discloses the claimed “using instant messaging system to communicate with the person and display the online status of the person (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which includes the graphical representation of the online status of each identified person is automatically updated by re-querying the at least one messaging account server for each identified person.

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As per claim 21, Lee and Thorner teach all the claimed subject matters as discussed in claim 20, except for explicitly disclosing the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person. Appelman teaches the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person (Appelman Fig. 28-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating the use of pop-up window as disclosed by Appelman (Appelman, Fig. 28-29). The motivation being to attract the user attention by using a pop-up window.

As per claim 22, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one context-sensitive menu for interacting with the retrieved information for each identified person (Appelman, Fig. 28-29)..

As per claim 23, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one hyperlink for accessing the retrieved information for each identified person via a computer pointing device (Appelman, Fig. 5).

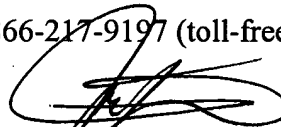
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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean M Corrielus
Primary Examiner
Art Unit 2162

September 27, 2006